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EXAMINER

RATHINASAMY, PALANI P

ART UNIT

PAPER NUMBER

3622

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/04/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/083,586	<b>Applicant(s)</b> ZIMMERMAN, STEPHEN M.	
	<b>Examiner</b> Palani P. Rathinasamy	<b>Art Unit</b> 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 2/27/2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 21 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 21 recites the limitation "Private Bureau Exchange" as the communication means. Applicant claims that it is used in a "manner that is well known." Examiner attempted a Google search with the term "Private Bureau Exchange" and came up with a total of 7 hits, none of which adequately explained the term. The specification or claim must be changed in order to enable one skilled in the art to understand this term. Examiner assumes that the term that applicant intended to use is "Private Branch Exchange" which is a local network.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 17 recites the limitation "receive commands from the remote content control" in the method for controlling the images. There is insufficient antecedent basis for this limitation in the claim. Applicant first introduces the "remote content control" in

dependent claim 7. Dependent claim 17 is NOT a dependent claim of claim 7 or any other claim that makes reference to the "remote content control."

***Claim Rejections - 35 USC § 102***

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**5. Claims 1-8, 10, 12, 14, 15, and 20-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Malackowski et al. (US 5,752,186, hereinafter known as "Malackowski").**

6. Regarding claim 1, 20, and 23, applicant teaches a system for communicating marketing data that: involves a display that displays marketing information, and a communication code, a data delivery system consisting of a memory for storing market data and a communications means to receive instructions from users and provide them with data. Malackowski teaches of a similar method. Displaying a communication code on a billboard (Col 1, Lines 23-27; Fig. 4 101(a), 101(c)); data delivery system (Col 3, Lines 1-3) that stores market data (Col 3, Lines 3-12; Col 12, Line 22); and a communications means to receive instructions from users (Col 2, Lines 55-60) and provide them with data (Col 3, Lines 1-12). The user requests data from the system. (Col 2, Lines 62-67; Col 3, Lines 1-3). The system consists of PC's, servers and databases (Fig 10.) that provide the user with the data that they request. (Col 12, Line 21-22). That data is stored in an "advertiser file". (Col 12, Line 22). Therefore, although Malackowski does not explicitly teach of memory for storing market data, it is inherent that it exists in the system.

7. Regarding claim 2 and 6, applicant further teaches that the data delivery system comprises a "data selection means" (Claim 2), particularly a menu (Claim 6), which processes instructions by the user. Malackowski teaches of a similar method of providing the user with an automated menu to select marketing data. (Col 2, Line 61; Col 3, Lines 1-12; Col 12, Lines 5-7, Line 21).

8. Regarding claim 3, applicant further teaches that the data selection is adapted to process instructions. Malackowski teaches that based on the user's keypad response (or voice response), the system provides the user with the marketing and other data. (Col 3; Lines 1-12).

9. Regarding claim 4, applicant further teaches that the system responds to the communication code as an input. Malackowski teaches that the user sees a code on a billboard (Col 1, Lines 23-27) and calls or enters that code on the their cell phone in order to access the system (Col 1, Line 56).

10. Regarding claim 5, applicant further teaches that system can forward marketing data to a location other than the communication device. Malackowski teaches a similar method whereby the user can select the system to mail "product/service information to their home or business". (Col 3, Line 3-4).

11. Regarding claim 7, applicant further teaches of a remote control that permits customers of the billboard to update the "marketing data". Malackowski teaches of a similar method whereby an advertiser can access the system to update the "fulfillment data" from a remote location. (Col 7, Lines 29-32).

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12. Regarding claim 8, applicant teaches that the remote control allows customers to remotely update the content of the menu. Malackowski teaches that a menu system allows the user to select the market data to receive. (Col 3, Lines 1-12). Malackowski teaches that the advertiser can change the market data from a remote location. (Col 29-32). If an advertiser were to delete specific market data, then it would update the corresponding menu option. Therefore, it is inherent that system allows the user to remotely update the content of the menu.

13. Regarding claim 10, applicant further teaches that the communication code is a phone number. Malackowski gives an example whereby a user sees a sign saying "CALL \*522" and responds by calling that phone number. (Col 2, Line 31).

14. Regarding claim 12, applicant further teaches that the device that the user uses is a wireless phone. Malackowski teaches of using a cellular phone. (Col 2, Line 49).

15. Regarding claim 14, applicant further teaches that the marketing information is text, graphic, video, etc. Malackowski teaches of similar marketing info. (Col 3, Lines 1-12).

16. Regarding claim 15, applicant further teaches that the marketing data comprises product or service offering details, and product or service promotions. Malackowski teaches of similar marketing info. (Col 3, Lines 1-12).

17. Regarding claim 21, applicant further teaches that the communication means uses a local network ("private bureau exchange"). Malackowski teaches of a similar local network. (Col 3, Line 50-61; Col 11, Lines 29-43; Fig. 10).

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18. Regarding claim 22, applicant teaches of a computer system comprising a recording means; memory for storing marketing data; and communication means to receive instructions from the users. Malackowski teaches of a similar method of recording means (Col 3, Lines 1-12); memory for storing marketing data (Col 3, Lines 3-12; Col 12, Line 22); and communication methods to receive instructions from the users (Col 2, Lines 55-60) and provide them with data (Col 3, Lines 1-12). Malackowski teaches that one of the stored marketing data is "audio listing of local retailers...". Therefore, it is inherent in Malackowski that there exists recording means to store this marketing data.

***Claim Rejections - 35 USC § 103***

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. **Claims 9, 11, 13, and 16-18, are rejected under 35 U.S.C. 103(a) as being unpatentable over Malackowski et al. (US 5,752,186, hereinafter known as "Malackowski") in view of Cabral (US 2003/0149601 A1). Cabral teaches of a billboard system whereby the display and scheduling of the billboards is remotely controlled.**

21. Regarding claim 9, 16 and 17, applicant further teaches that the remote control allows the display to be updated remotely. Applicant also teaches that the display is a

"video billboard system" (Claim 16). Malackowski teaches of the display unit whereby advertisements and codes are displayed. (Col 2, lines 22-35).

Malackowski does not explicitly teach remote updating of what is being displayed on the display unit or of video displays. Cabral teaches of electronic displays that are updated remotely. (Summary of the Invention, [0010], [0017]; Fig. 3). Therefore it would have been obvious to one of ordinary skill, at the time of the invention, to use electronic displays that are remotely controlled and updated. One would have been motivated to do so in order to reduce the costs (labor, supplies, etc) of having to manually change the displays. (Background of the Invention, [0003] – [0004]).

"Electronic billboards provide the advantage in that the advertising displays can be easily and quickly changed." (Background of the Invention, [0005]).

22. Regarding claim 11, applicant teaches that the communication device is web enabled; the communication code on the display is a URL; and the communication means is through the Internet. Malackowski teaches that the communication is through the phone; the code is number; and the communication is through wireless phones.

Malackowski does not explicitly teach of a web enabled device; URL; or communication through the Internet. Cabral teaches that observers can interact with the billboard with a PDA (personal digital assistant) or other device. (Summary of the Invention, [0010], [0077]). Cabral further teaches that the billboard can display a link (ie. URL) which the PDA can use to connect to the sponsors website through the Internet. (Detailed Description, [0050]). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided a URL on the

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billboard in order to be accessed by a web enabled device. One would have been motivated to do so in order to allow users other mediums to obtain marketing and advertising information.

23. Regarding claim 13, applicant teaches of various communication devices. Marlackowski teaches of a cellular phone capable of text messages. (Summary of the Invention).

Marlackowski does not explicitly teach that the user's communication device is a personal digital assistant. Cabral teaches that the user's communication device is a PDA. (Summary of the Invention, [0010]). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have the communication device be a PDA. One would have been motivated to do so in order to provide access to marketing data for other common devices, such as a PDA.

24. Regarding claim 18, applicant teaches that display is able to receive commands from the customers via the remote content control. Marlackowski teaches of a billboard display and a corresponding marketing system. (Summary of the Invention).

Marlackowski does not explicitly teach that the display receives commands from the advertiser in order to control the images on the display. Cabral teaches that the billboards are connected to the network and are controllable by the advertiser. (Summary of the Invention, [0010], [0015]). Therefore, it would have been obvious to one of ordinary skill, at the time of the invention, to have the display able to receive commands from the advertiser to switch images. One would have been motivated to do

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so in order to give the advertiser as much control as possible over the images being displayed on the billboard.

**25. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Malackowski et al. (US 5,752,186) in view of Applicant's Specification (US 2003/0028430 A1).**

26. Regarding claim 19, applicant teaches that the advertisement screen is combined with a "diffuser panel, an LED screen, or a plasma screen." Marlackowski teaches of a static billboard. (Summary of the Invention).

Marlackowski does not explicitly teach of a advertising screen combined with a diffuser panel, LED, or plasma screen, however, applicant admits in the specification that these technologies are "well known." (Specification, [0002]). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have used a advertising screen combined with a diffuser panel, LED, or plasma screen. One would have been motivated to do so in order to choose any of the available and "well known" technologies at the time.

### ***Conclusion***

**Examiner's Note:** Examiner has cited particular columns, line numbers, and paragraphs in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the applicant, in preparing

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responses, fully consider each of the references in its entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Palani P. Rathinasamy whose telephone number is (571) 272-5906. The examiner can normally be reached on M-F 8:30-5p.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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